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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,762	09/21/2001	Ward W. Chilton	0112300-811	6315

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EXAMINER	
JONES, SCOTT E	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/960,762	CHILTON ET AL.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02112004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on February 11, 2004 in which applicant amends claims 1, 19, 29, 32, 39, and 43, and submits a supplemental information disclosure statement. Claims 1-48 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-18, 32-37, 39-41, and 43-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1).

Cannon et al. discloses a gaming system having two or more gaming machines connected via a network wherein the gaming machines provide players an opportunity to enter tournament play. Players may qualify for tournament play by obtaining a predetermined combination of symbols in a primary or base game. Furthermore, once a player qualifies for tournament play, the player may defer to play in tournament play until a later time (Paragraphs 3, 39, 49, and 78).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 19-29 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1).

Cannon and Cannon et al. each disclose all of the claimed subject matter except for the game being implemented in a bonus game. However, to one having ordinary skill in the art at the time of Applicant's invention it was notoriously well known in implement any type of game in a bonus game on a gaming machine. One would be motivated to do so because bonus games in gaming machines offer awards in addition to base game awards making gaming machines with bonus games very appealing to players.

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1) in view of Vazquez, Jr. et al. (U.S. 4,695,053).

Cannon and Cannon et al. each disclose all of the claimed subject matter except for a bonus game including a plurality of player selectable selections and wherein the qualifying outcome is associated with at least one selection (claim 30).

Vazquez, Jr. et al., like Cannon and Cannon et al., teach of games that are played on gaming machines, such as slot machines. Therefore, Vazquez, Jr. et al., Cannon, and Cannon et al. are analogous art. Vazquez, Jr. et al. teaches of a gaming device wherein a player selects three digits on a display. The player then rotates the reels by pulling the gaming machine handle to produce a randomly generated outcome. The gaming device then determines whether any of the player selected numbers are obtained on the win line. The player is awarded if the player

selected numbers match one, two, or three of the numbers that are randomly generated on the reels (column 1, line 40-column 6, line 16).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Vazquez's player selectable winning combination feature in Cannon or Cannon et al. One would be motivated to do so because allowing a player to select a winning combination would make a player feel like they have control over whether they will qualify for a future event or tournament.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1) in view of Take Your Pick.

Cannon and Cannon et al. each disclose all of the claimed subject matter except for a bonus game including a player offer acceptance type game and the qualifying outcome is associated with one of a plurality of offers made to the player (claim 31).

Take Your Pick, like Cannon and Cannon et al., teach of games that are played on gaming machines, such as slot machines. Therefore, Take Your Pick, Cannon, and Cannon et al. are analogous art. Take Your Pick teaches of a player offer acceptance type game wherein the outcome is associated with one of a plurality of offers made to the player. It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Take Your Pick player offer acceptance type game in Cannon or Cannon et al. One would be motivated to do so because allowing a player to accept or reject an outcome would make a player feel like they have control over whether they will qualify for a future event or tournament. Furthermore, this feature breathes new life into a gaming machine game, giving the

player the thrill of taking a risk and the opportunity to actually employ a bit of strategy to a game that traditionally is based solely on dumb luck.

8. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1) in view of Weiss (U.S. 6,309,299). Cannon and Cannon et al. each disclose all of the claimed subject matter except for a theme of a tournament is related to the theme of the qualifying gaming devices (claim 42). Weiss, like Cannon and Cannon et al., teach of games that are played on gaming machines, such as slot machines. Therefore, Weiss, Cannon, and Cannon et al. are analogous art. Weiss teaches of a gamine device and method for head to head or tournament play. In particular, Weiss teaches of a gaming device based on a battleship game theme for tournament play (Figs. 1-6 and column 2, line 40-column 3, line 2). It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate a theme of the gaming device in the theme of the tournament. One would be motivated to do so because particular themes, such as battleship, are very familiar and popular with game players thereby increasing player participation and profit for casino operators.

Response to Arguments

9. Applicant's arguments filed February 11, 2004 have been fully considered but they are not persuasive.

10. Applicant's arguments, see page 10 and the supplemental information disclosure statement, filed February 11, 2004, with respect to the objection to the information disclosure statement has been fully considered and is persuasive. The objection of the information disclosure statement has been withdrawn.

11. Applicant's arguments, see pages 6 and 10, filed February 11, 2004, with respect to the rejection to claim 29 under 35 U.S.C. 112, second paragraph has been fully considered and is persuasive. The rejection of claim 29 under 35 U.S.C. 112, second paragraph has been withdrawn.

12. Applicant amends claims 1, 19, 29, 32, 39, and 43 to allegedly patently distinguish the claims over the prior art. In particular, applicant alleges the prior art does not disclose that the tournament is selected by the player from a plurality of tournaments and how the paytable accounts for the outcomes. However, the examiner respectfully disagrees. Cannon et al. (U.S. 2002/0039923 A1) discloses a player may select from a plurality of tournaments (Paragraphs 3, 39, 49, and 78). Furthermore, Cannon et al. discloses how the paytables account for the outcomes (Paragraph 40).

13. Therefore, for the reasons stated hereinabove, the examiner maintains the rejections as stated in Office Action, Paper No. 5.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sej

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